REMARKS

Claims 1, 2, and 4-21 were pending in this application.

Claims 1, 2, and 4-21 have been rejected.

Claim 2 has been amended as shown above.

Claims 1, 2, and 4-21 remain pending in this application.

Reconsideration and full allowance of Claims 1, 2, and 4-21 are respectfully requested.

I. OBJECTION TO CLAIMS

The Office Action objects to Claims 12-20 as having an improper order. In particular, the Office Action notes that a claim that depends from a dependent claim should not be separated by any claim that does not also depend from the dependent claim. The Applicant respectfully traverses this objection.

Claims 12-20 were not contained in the originally-filed application. Claims 12-20 were added in the AMENDMENT AND RESPONSE filed on October 30, 2003. Claims 12-14 depend from Independent Claim 1. Claims 15 and 16 depend from Independent Claim 5. Claims 17 and 18 depend from Independent Claim 8. Claims 19 and 20 depend from Independent Claim 10. This represents the proper ordering for the new dependent claims.

Accordingly, the Applicant respectfully requests withdrawal of the objection to the claims.

II. REJECTIONS UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 2, 4-7, 10, and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,962,992 to Huang et al. ("*Huang*") in view of U.S. Patent No. 6,188,181 to Sinha et al. ("*Sinha*"). The Office Action rejects Claims 8, 9, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* and *Sinha* in view of U.S. Patent No. 5,847,955 to Mitchell et al. ("*Mitchell*"). The Office Action rejects Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Huang*, *Sinha*, and *Mitchell* in view of U.S. Patent No. 6,333,605 to Grouev et al. ("*Grouev*"). The Office Action rejects Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* and *Sinha* in view of "admitted prior art" ("*APA*"). The Office Action rejects Claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Huang*, *Sinha*, and *APA* in view of U.S. Patent No. 5,986,574 to Colton ("*Colton*"). The Office Action rejects Claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Huang*, *Sinha*, *APA*, and *Colton* in view of U.S. Patent No. 6,675,196 to Kronz ("*Kronz*"). The Office Action rejects Claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* and *Sinha* in view of U.S. Patent No. 5,295,154 to Meier et al. ("*Meier*"). The Office Action rejects Claim 18 under 35 U.S.C. § 103(a) as being unpatentable over *Huang*, *Sinha*, *Mitchell*, and *Meier*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP

§ 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Claim 1 recites accepting a user confirmation "in response to a visual confirmation" performed by each of "plural lighting devices" upon "selection of each of the plural lighting

devices on [a] remote control."

The Office Action notes that *Huang* recites the use of "visual confirmation" at column 10, lines 19-22 but that *Huang* fails to disclose these elements of Claim 1. (*Office Action, Page 3, Second paragraph*). The Office Action then asserts that *Sinha* discloses these elements of Claim 1 at column 7, lines 46-56 and that it would be obvious to combine *Huang* and *Sinha*. (*Office Action, Page 3, Second paragraph*).

First, the cited portion of *Huang* simply recites that a "master controller" uses sounds and flashing LEDs to guide a user through "installation, verification, and monitoring." (*Col. 10, Lines 16-19*). As an example, when a "slave unit" is successfully installed, an LED will flash for three seconds. (*Col. 10, Lines 19-22*).

Claim 1 clearly recites that the "visual confirmation" is performed by each of "plural lighting devices" that are controlled by a "remote control." In other words, the "visual confirmation" is performed by a device being controlled, not by the remote control itself. The cited portion of *Huang* simply recites that an LED in the master controller flashes in response to installing a slave unit. This portion of *Huang* lacks any mention that the slave unit flashes an LED or performs some other act in response to being installed. In particular, this portion of *Huang* lacks any mention of accepting a user confirmation "in response to a visual confirmation performed by each of the plural lighting devices" upon selection of that device "on the remote control" as recited in Claim 1.

Second, the cited portion of *Sinha* recites features of an "interactive display," which includes LEDs and pushbutton switches. (*Col. 7, Lines 38-41*). When a particular button is

repeatedly pressed on the interactive display, different LEDs become illuminated. (*Col. 7, Lines 47-49*). The LEDs correspond to different programs stored in the interactive display. (*Col. 7, Lines 49-57*).

Once again, Claim 1 clearly recites that a "visual confirmation" is performed by each of "plural lighting devices" that are controlled by a "remote control." This portion of *Sinha* simply recites that LEDs in a display are illuminated when different programs in that display are selected. This portion of *Sinha* lacks any mention of flashing LEDs on one device in response to an association involving another device. In particular, this portion of *Sinha* lacks any mention of accepting a user confirmation "in response to a visual confirmation performed by each of the plural lighting devices" upon selection of that device "on the remote control" as recited in Claim 1.

Huang and *Sinha* both fail to disclose, teach, or suggest a "visual confirmation" that is "performed by each of the plural lighting devices" upon selection of that device "on the remote control" as recited in Claim 1. As a result, the proposed *Huang-Sinha* combination also fails to disclose, teach, or suggest these elements of Claim 1.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claim 1 (and its dependent claims).

Claim 5 recites an "enumeration mode" utilized to associate plural lighting devices with an apparatus "in response to a visual confirmation performed by each of the plural lighting devices upon selection of each of the plural lighting devices by [a] processor" in the apparatus. As described above, the proposed *Huang-Sinha* combination fails to disclose, teach, or suggest

these elements of Claim 5.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claim 5 (and its dependent claims).

Claim 8 recites "means for initialization and binding" plural slave lighting devices and a master device "in response to a visual confirmation performed by each of the plural slave lighting devices upon selection of each of the plural slave lighting devices on the master device." As described above, both *Huang* and *Sinha* fail to disclose, teach, or suggest these elements of Claim 8. *Mitchell* is not cited by the Office Action as disclosing, teaching, or suggesting these elements of Claim 8. As a result, the proposed *Huang-Sinha-Mitchell* combination fails to disclose, teach, or suggest these elements of Claim 8.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claim 8 (and its dependent claims).

Claim 10 recites communicating a "visual signal" at each of plural slave devices "upon selection of each of the slave devices on [a] master remote control." As described above, the proposed *Huang-Sinha* combination fails to disclose, teach, or suggest these elements of Claim 10.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claim 10 (and its dependent claims).

Claim 21 recites communicating a "visual signal" at each of a plurality of slave devices "upon selection of each of the slave devices on [a] master remote control." As described above, the proposed *Huang-Sinha* combination fails to disclose, teach, or suggest these elements of

Claim 21.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claim 21.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections and full allowance of Claims 1, 2, and 4-21.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that all pending claims in this application are in condition for allowance and respectfully requests allowance of such claims.

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PATENT

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@davismunck.com.*

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 29 Nov. 2004

John T. Mockler
Registration No. 39,775

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *jmockler@davismunck.com*